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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,764	12/17/2001	Ludwig Bohm	0775/00025	2606

23416 7590 02/06/2004

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EXAMINER

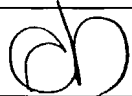
NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/018,764	Applicant(s) BOHM ET AL. 
	Examiner Sandra M. Nolan	Art Unit 1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): the 35 USC 112 rejection of claims 1-8.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: the arguments therein are not convincing.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: 9 and 10.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See the attachment.

ATTACHMENT TO ADVISORY ACTION

Claims

1. Claims 1-10 are pending. Claims 9-10 are withdrawn for reciting inventions that are properly restricted out under 35 USC 121 and 372. See sections 2-10 of the 05 September 2003 office action (hereinafter "the final rejection").

Note: Claims 9 and 10 should have been labeled "(withdrawn)".

Entry of Proposed Amendment/ Rejection Withdrawn

2. The proposed amendment to the claims overcomes the 35 USC 112 rejection of claims 1-8 (see section 16 of the final rejection). The 35 USC 112 rejection is withdrawn because the reference to "MFI" value was corrected by the amendment.

Rejection Maintained

3. The obviousness-type double patenting rejection over US 5,908,679, set out in section 7 of the 08 April 2003 office action, is maintained for reasons of record.

Response to Arguments

4. Applicant's arguments filed in the 08 January 2004 response have been fully considered but they are not persuasive.

On page 5 of the 08 January 2004 response, applicants state that the instant invention is a further development of the pipe covered by US 5,908,679.

The examiner agrees and asserts that this one principal reason why rejection for obviousness-type double patenting is proper.

On page 6, applicants argue that every improvement is strongly related with it starting point.

The examiner agrees and asserts that this another principal reason why rejection for obviousness-type double patenting is proper.

On page 6, applicants argue that the working example demonstrates how the mechanical strength of the claimed pipe is improved by means of selecting special parameters, such as density, chemical composition and molecular mass.

Since, as applicant acknowledges in the third paragraph on page 6 of their arguments, these parameters are all discussed in the '679 patent, the optimization of mechanical strength by routine experimentation to find optimal values of density, chemical composition and molecular mass is deemed an obvious way of operating within the teachings of the '679 patent.

On page 6, applicants argue that there is no prior art reference to support the obviousness of the instant claims over those of the '679 patent.

However, the examiner finds that the obviousness is based upon the skilled artisan's desire to optimize his or her results using the '679 technology. As in re Peterson, 65 USPQ2d 1379 (Fed.Cir. 2003), says, the desire of skilled artisans to improve upon what is known provides motivation to determine the best parameters to use when carrying out an invention.

On page 7, applicants argue that the invention described in this case is a surprising step in the right direction.

However, the optimization of properties by the manipulation of parameters is deemed to be suggested by the teachings of the '679 patent and is, therefore, obvious over it.

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Also on page 7, applicants argue that the increase in density and the decrease in MFI₅, when done in combination with the ethylene feed, comonomer feed and hydrogen pressure used give an unforeseeable -- in applicants' words "incredible" -- improvement in properties.

However, the record does not demonstrate, via convincing objective evidence, that the improvements achieved are indeed unforeseeable, or unexpected, let alone "incredible".

Conclusion

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 571/272-1495. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498. The general fax number for the art unit is 703/872-9306.



S. M. Nolan
Patent Examiner
Technology Center 1700

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